

**R E M A R K S**

**Disposition of the Claims**

The Examiner has rejected Claims 8, 9 and 11 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The Examiner has allowed Claims 1-7, 10 and 12-24, for which the Applicant appreciates.

The Specification at page 9, line 4 has been amended. Support for this amendment is found at page 4, line 30.

Claims 1, 8, and 9 have been amended. Support for the amendment of Claim 1 is found at page 7, lines 26-27. Support for the amendment of Claims 8 and 9 is found at page 12, lines 17-31.

Claims 15 and 16 have been amended to correct typographical errors.

**Response to the Examiner's Rejections**

The Examiner has rejected Claims 8, 9 and 11 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that "[t]he claim(s) contain(s) subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time of the application was filed, had possession of the claimed invention."

The Examiner further asserts that "it is not seen where the step in Claim 8 of enhancing the inverting of the emulsion through inclusion of a 'delayed release agent,' which will 'alter the pH of the emulsion as the emulsion warms.'"

In accordance with 35 U.S.C. §112, which sets forth the requirements for written description in a patent application, the "specification shall contain a written description of the invention." See MPEP 2163. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See MPEP 2163, *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319.

The Examiner asserts that the Applicant has failed to comply under 35 U.S.C. §112.

Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §112, first paragraph, rejection of Claims 8, 9 and 11 as failing to comply with the written description requirement. Applicant respectfully traverses the Examiner's rejection of the presently claimed invention for the reasons which follow. It is respectfully submitted that the Applicant had possession of the invention at the time the application was filed.

First, Claim 1(c) has been amended to claim that the first and second chemical are prepared and mixed with one another. This amendment better describes the relationship of the first chemical and the second chemical - that the two chemicals are mixed together and not reacted.

Dependent Claim 11 claims that the first treatment chemicals include at least one of a scale inhibitor, a proppant, a polymer and a conformance controller. The Examiner rejected Claim 11, which is dependent upon Claim 1 and encompasses the limitations of Claim 1, because, as originally claimed, a proppant or a polymer would have to be *reacted* with the first chemical. More specifically, the Examiner states that "it is not clear

how either the 'proppant' or 'polymer' embodiments of the 'first treatment chemical' will experience or undergo a reaction with the retention enhancing chemical or reactant, as no such specific reaction(s) involving these first treatment chemical embodiments have been set forth in the specification."

A proppant (i.e., sand) and a polymer are well known additives in the art that are used in a well bore to improve the viscosity and flow of the fluid in the well bore. These additives are generally mixed with another fluid and are not reacted. A skilled artisan would recognize that a proppant and a polymer may be mixed with another chemical, such as the second treatment chemical in the presently claimed invention. Applicant asserts that the amendment to Claim 1 clarifies that the first and second chemicals are mixed with one another and are not reacted. Accordingly, there is no chemical reaction between the proppant/second chemical and the polymer/second chemical.

Furthermore, with regard to the use of the term "conformance controller" in Claim 11, Applicant asserts that this term is a term of art that is well recognized in the art. A skilled artisan would recognize that a conformance controller is a treatment chemical that may be used to equalize flow rates in wells. For example, U.S. Patent No. 6,454,003 describes "conformance control treatment" as physical and chemical methods that are used to divert injected fluids from "thief" zones. (See column 1, lines 34-54). U.S. Patent No. 4,503,912 also describes conformance controlling methods, which employ chemicals such as high molecular polymers used in concert with cross-linking agents, to improve conformance in the formation by reducing the permeability of the highly permeable zones. (See column 1, lines 14-68 and column 2, lines 1-25). U.S. Patent No. 4,475,593 also describes methods of conformance control.

In the presently claimed invention, a conformance controller is used as a treatment chemical that is mixed with a first aqueous phase which is eventually injected into a subterranean formation, and, ultimately, improve conformance in the subterranean

formation. Applicant further asserts that the presently claimed invention has been described in sufficient detail that one skilled in the art may reasonably conclude that the inventor had possession of the claimed invention.

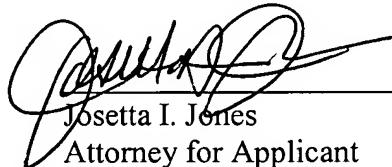
Second, Claims 8 and 9 have been amended to better describe the scope of the invention. Specifically, in Claim 8, the term "delayed release agent" was changed to "retention enhancing chemical" to describe the relationship between the retention enhancing chemical and the pH of the emulsion. Support for the amendment and the claim are found at page 12, lines 24-26 of the Specification, which describes the effect of a retention enhancing chemical on the pH of the emulsion. Also, in Claim 9, the term "delayed release agent" was changed to "retention enhancing chemical". Support for the amendment of Claim 9 is found at page 12, line 27 which discloses sulfamic acid as a retention enhancing chemical.

Applicant asserts that the amendment of Claims 1, 8, and 9 would lead one skilled in the art to conclude that the inventor had possession of the claimed invention.

Conclusion

For the reasons stated above, Applicant respectfully submits that the rejection of Claims 8, 9 and 11 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement should be withdrawn; and, furthermore, Applicant respectfully submits that this application is in condition for allowance and notice to that effect is earnestly solicited.

Respectfully submitted,



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